



Attorney Docket No. 23380.00

Customer No. 37833

Confirmation No. 7856

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

IN THE PATENT APPLICATION OF:

APPLICANT : JUDY A. MARTIN

APPL. NO. : 10/685,406

ART UNIT : 3722

FILED : OCTOBER 16, 2003

EXAMINER : CARTER, M.

FOR : BIRTHDAY CALENDAR

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF BRIEF ON APPEAL

Sir:

Transmitted herewith are:

1. Appeal Brief (10 pages) in triplicate.
2. Appendix containing 4 pages, (15 claims) in triplicate.
3. Check in the amount of \$250.00.

Any additional fees pertaining to this matter may be charged to Deposit Account No. 12-1662 of the undersigned.

Respectfully submitted,

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BRIEF ON APPEAL

Sir:

This is a Brief in support of Applicant's Appeal from the
Examiner's decision finally rejecting Claims 1-6, 8, 9, and 11-17.

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I. REAL PARTY IN INTEREST

Judy A. Martin is the real party in interest. This application has not been assigned.

II. RELATED APPEALS AND INTERFERENCES

No related appeals or interferences are known to appellant.

III. STATUS OF CLAIMS

This is a Utility Patent Application. The claims on appeal are Claims 1-6, 8, 9, and 11-17. An Appendix containing a copy of these appealed claims is attached.

Claims 1-6, 8, 9, and 11-17 stand finally rejected under § 103(a) as being unpatentable over the Rosen reference, U.S. Patent No. 5,987,825, in view of the Kim reference, U.S. Patent No. 5,123,191. Claim 8 stands finally rejected under § 103(a) as being unpatentable over the Rosen reference in view of the Kim reference and further in view of the Selman reference, U.S. Patent No. 4,852,282.

IV. STATUS OF AMENDMENTS

In an amendment filed on August 13, 2004, Claims 1-6, 8, 9, 12, 13, and 16 were amended, and Claims 7 and 10 were canceled. All remaining claims were rejected by the Examiner in a Final Office Action dated January 14, 2005. A Response After Final, in which the claims were not amended, was filed on April 5, 2005. This response was acknowledged in an Advisory Action dated April 13, 2005, but was not considered to overcome the rejections.

V. SUMMARY OF INVENTION

The present invention is a birthday calendar 10. The calendar 10 has two sections, a twelve-month (or annual) chart 12 and a monthly calendar 24. The chart 12 is made of construction paper, paperboard, cardboard or similar paper material that is capable of recording indelible ink, either by imprinting or written by pen, to provide a permanent record of events. The monthly calendar 24 is a dry-erase board, or similar material, that is marked by erasable ink. If desired, the monthly calendar 24 may have an anchoring piece to hold a dry-erase marker to it.

VI. ISSUES

The issues presented for consideration by the Board of Appeals is as follows:

Whether, pursuant to 35 U.S.C. § 103(a), Claims 1-6, 8, 9, and 11-17 are rendered obvious in view of the combination of the Rosen reference and the Kim reference.

Whether, pursuant to 35 U.S.C. § 103(a), Claims 1-6, 8, 9, and 11-17 are rendered obvious in view of the combination of the Rosen reference and the Kim reference and the Selman reference.

VII. GROUPING OF CLAIMS

Claims 1-6, 8, 9, and 11-17, as grouped by the Examiner for the purposes of the combination of the Rosen and Kim references, do not stand or fall together. Specifically, Claims 8 and 15 do not stand or fall together with the other claims in this grouping by the Examiner.

Claim 8, as grouped by the Examiner for the purposes of the combination of the Rosen, Kim, Selman references, by definition stands alone.

VIII. ARGUMENTS

The Examiner's contention that Rosen discloses the claimed invention except for the transparent protective cover is not supported by the realistic teachings afforded by the primary reference. The Rosen patent discloses a modular message center having a main module and a supplemental module. A frame member divides the main module into a first area and a second area. The first area includes an attachment device and is dimensioned to hold a calendar. The second area on the main module is a cork board. Fig. 4 shows the main module holding a prefabricated single year calendar that displays one calendar month at a time, while Fig. 5 shows the main module holding a prefabricated single year calendar that displays two successive months at a time. After the month and year expire, a new calendar must be furnished for use with the modular message center. The supplemental module also has multiple areas divided and defined by a frame. One area is a dry-erase board, second and third areas are dimensioned to hold accessory articles such as an eraser and a pad of notes.

In contrast to the modular message device taught by Rosen, Applicant's claimed invention is a single sheet twelve-month chart joined to a monthly calendar. The chart has been prefabricated to display imprinted rows and columns that define a plurality of

memorandum spaces for permanently recording events and the calendar has been prefabricated to display imprinted rows and columns that define a plurality of memorandum spaces for temporarily recording events. A protective transparent cover is removably disposed over the single sheet twelve-month chart. Applicant's invention is used perennially since information can be added to the single sheet twelve-month chart and the calendar can be updated monthly. The birthday calendar set forth by the present claims is structurally and functionally unrelated to the message center taught by Rosen.

In order to supplement the apparent deficiencies of the primary reference to Rosen, the Examiner relies upon the secondary reference to Kim. The patent to Kim discloses a wall and desk calendar display device that combines a prefabricated calendar with a calendar frame. Kim's transparent cover includes a transparent vinyl back pocket cover, a transparent vinyl front cover extending from a transparent vinyl top cover. The transparent vinyl top cover forms a pocket for tightly inserting an upper end of a calendar pad. Applicant's transparent cover is removably disposed over and protects the single sheet twelve-month chart.

The Examiner's combination of Kim with Rosen is unwarranted since there exists no motivation for combining the transparent

cover of Kim with a message module center of Rosen. It is respectfully submitted that the Examiner cannot pick and choose individual features of the references to meet the claim.

The only guidance to make such a combination is provided by Applicant's own disclosure, which cannot appropriately be used as a blueprint to meet the instant claim. See Uniroyal Inc. v. Rudkin-Wiley Corp., 5 USPQ 2d 1434 (Fed. Cir. 1988). It is impermissible hindsight to use the claim as a frame and the prior art references as a mosaic to piece together a facsimile of the invention. W.L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 312 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Regarding Claim 8, the Examiner attempts to buttress the rejection by adding the Selman reference to the Rosen/Kim combination. The Examiner notes that Selman discloses a magnetic calendar having a cover made of transparent plastic material or glass and concludes that it would have been obvious to provide Rosen/Kim with a glass cover.

It should be noted that obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984). The Examiner has again engaged in impermissible hindsight.

The Federal Circuit in In re Dembiczak, 50 USPQ2d 1614 (Fed.Cir. 1999) deprecated rejections based upon "a hindsight-based obviousness analysis" and emphasized that what is required is a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The "showing must be clear and particular" and broad conclusory statements regarding the teaching of multiple references and "a mere discussion of the ways that the multiple prior art references can be combined to read on the claimed invention" are inadequate.

Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific...findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis".

Regarding Claim 15, it is believed that this claim is patentable independently from Claim 1 and should not be grouped with Claim 1 for purposes of the Rosen/Kim rejection. the applied combination fails to show the "paper having a erasable plastic cover disposed thereon." While it is true that the Examiner could make the statement that this limitation is obvious or possibly find a reference and bodily incorporate it into the Rosen/Kim

combination, such would merely be another example of the application of impermissible hindsight.

Applicant contends that one skilled in the art would not be motivated to combine the references in the manner suggested by the Examiner. Applicant further contends that even if the references were properly combinable, the above noted deficiencies of the primary reference to Rosen are not remedied by the teachings afforded by the secondary references.

Further, Applicant notes that the combinations relied upon by the Examiner do not teach the configuration of the printed matter.

The "differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the printed matter." In re Gulack, 217 USPQ 401 (CAFC 1983).

It is respectfully submitted that the printed matter is related to the substrate. The 12-month chart is related to the monthly calendar, i.e. the monthly calendar is an enlarged portion of the 12-month chart. The monthly calendar is one of the months from the 12-month chart and shows the data in an enlarged format.

The configuration of the monthly calendar and the 12-month chart (so that they are seen in the same view) is necessitated by the presentation of the printed matter.

IX. CONCLUSION

In view of the foregoing arguments, Appellant respectfully requests the Board to reverse all rejections of the claims as set forth in the Final Office Action of January 14, 2005 and as maintained in the Advisory Action dated April 13, 2005.

The fee for filing the brief in support of the appeal is attached.

Respectfully submitted,



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APPENDIX



Application No.: 10/685,406
Art Unit: 3722

Docket No. 23380.00
Confirmation No. 7856

Pending Claims

1. A birthday calendar for recording birthdays and other annual dates, comprising:

a single sheet twelve-month chart made of an ink accepting material having vertical and horizontal parallel arranged intersecting lines imprinted thereon forming rows and columns and defining a plurality of memorandum spaces for permanently recording therein birthdays and other annually recurring events;

a transparent protective cover removably disposed over said twelve-month chart; and

a monthly calendar joined to the chart such that the calendar and chart are simultaneously visible, said monthly calendar having imprinted thereon seven parallel vertical rows intersecting seven parallel horizontal columns defining memorandum spaces for removably imprinting birthdays and other monthly events therein as displayed on the chart, the monthly calendar having an erasable surface for reuse from month-to-month.

2. The birthday calendar according to claim 1, wherein said chart has twenty-five columns intersected by a plurality of rows to define the plurality of memorandum spaces.

3. The birthday calendar according to claim 2, wherein columns two through twenty-five of the chart are grouped in pairs of adjacent columns, each pair having a first column corresponding to a month and a second column corresponding to a year.

4. The birthday calendar according to claim 3, wherein the plurality of rows of the chart includes a top row, the first column of each pair of adjacent columns in the top row having indicia therein designating months from January through December displayed therein, the second column of each adjacent pair in the top row having indicia representing the word "year" displayed therein, whereby the top row defines a horizontal legend for the chart.

5. The birthday calendar according to claim 4, wherein said twenty-five columns includes a first column, the first column having indicia displayed therein representing numbers one through thirty-one in separate rows, whereby the first column defines a vertical legend for the chart, an intersection of one of the rows with one of the grouped pairs of adjacent columns defining the memorandum space for recording an event and a year in which the event occurred in order to permanently record the month, day and year of the event.

6. The birthday calendar according to claim 5, wherein said chart further comprises at least one blank row disposed between each of the rows displaying the indicia representing numbers one through thirty-one, whereby multiple events occurring on identical months and days may be permanently recorded.

8. The birthday calendar according to claim 1, wherein said protective cover is made from glass.

9. The birthday calendar according to claim 1, wherein said protective cover is made from plastic.

11. The birthday calendar according to claim 1, wherein said chart is made from paper.

12. The birthday calendar according to claim 1, wherein the seven rows of said monthly calendar include a top row displaying indicia representing days of a week from Sunday through Saturday, the top row defining a horizontal legend for said monthly calendar.

13. The birthday calendar according to claim 12, wherein said monthly calendar further comprises a blank date space disposed in each of the memorandum spaces defined by said rows and columns below the top row, the blank space date being sized and dimensioned for writing a number from one through thirty-one therein representing a day of a month.

14. The birthday calendar according to claim 1, wherein said monthly calendar is made from whiteboard.

15. The birthday calendar according to claim 1, wherein said monthly calendar is made from paper having an erasable plastic cover disposed thereon.

16. The birthday calendar according to claim 1, wherein said monthly calendar further comprises erasable spaces dimensioned for temporarily designating a current month and year.

17. The birthday calendar according to claim 1, wherein said chart further comprises indicia imprinted adjacent said memorandum spaces for designating a title and owner of the birthday calendar.